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Paper No. 11

PAUL LEURY  
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In re Application of:  
Wheeler, et al.  
Application No. 09/681,530  
Filed: 24 April, 2001  
Attorney Docket No. 800528

LETTER

**COPY MAILED**

**OCT 31 2001**

**OFFICE OF PETITIONS**

Dear Mr. Leury:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. §116 (United States Code),<sup>1</sup> and 37 C.F.R. §1.47(a), Rules of Practice in Patent Cases.<sup>2</sup>

Should a patent be granted on the application you will be designated therein as a joint inventor.

<sup>1</sup> The statute, 35 U.S.C. §116, provides in pertinent part:

**35 U.S.C. §116 Inventors.**

\* \* \*

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

\* \* \*

[Amended Aug. 27, 1982, Public Law 97-247, sec 6(a), 96 Stat. 320; Nov. 8, 1984, Public Law 98-622, sec. 104(a), 98 Stat. 3384]

<sup>2</sup> The regulations at 37 C.F.R. §1.47 provide:

**§1.47 Filing when an inventor refuses to sign or cannot be reached.**

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(i) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(i), and the last known address of all of the inventors. The Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to all of the inventors at the addresses stated in the application and publish notice of the filing of the application in the Official Gazette. An inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.

[47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

As a named inventor:

- you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 C.F.R. §1.19<sup>3</sup>) or make your position of record in the application;
- alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you.

If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or

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<sup>3</sup>The regulations at 37 C.F.R. §1.19 provide:

**§1.19 Document supply fees.**

The Patent and Trademark Office will supply copies of the following documents upon payment of the fees indicated:

- (a) Uncertified copies of patents:
  - (1) Printed copy of a patent, including a design patent, statutory invention registration, or defensive publication document, except plant or statutory invention registration containing color drawing:
    - (i) Regular service, which includes preparation of copies by the Office within two to three business days and delivery by United States Postal Service or to an Office Box; and preparation of copies by the Office within one business day of receipt and delivery by electronic means (e.g., facsimile, electronic mail)....\$ 3.00
    - (ii) Next business day delivery to Office Box....\$ 6.00
    - (iii) Expedited delivery by commercial delivery service....\$ 25.00
  - (2) Printed copy of a plant patent in color...\$ 15.00
  - (3) Copy of a patent (other than a plant patent) or statutory invention registration containing color drawing (see § 1.84(a)(2))....\$ 25.00
- (b) Certified and uncertified copies of Office documents:
  - (1) Certified or uncertified copy of the paper portion of patent application as filed:
    - (i) Regular service...\$ 15.00
    - (ii) Expedited regular service...\$ 30.00
  - (2) Certified or uncertified copy of patent-related file wrapper and contents
    - (i) File wrapper and paper contents of 400 or fewer pages....\$200.00
    - (ii) Additional fee for each additional 100 pages or portion thereof....\$40.00
    - (iii) Additional fee for certification....\$25.00
  - (3) Certified or uncertified copy on compact disc of patent-related file-wrapper contents that were submitted on compact disc:
    - (i) First compact disc in a single order....\$55.00
    - (ii) Each additional compact disc in a single order of paragraph (b)(3)(i) of this section....\$15.00
  - (4) Certified or uncertified copy of Office records, per document except as otherwise provided in this section....\$25.00
  - (5) For assignment records, abstract of title and certification, per patent....\$ 25.00
- (c) Library service (35 U.S.C. 13): For providing to libraries copies of all patents issued annually, per annum....\$ 50.00
- (d) For list of all United States patents and statutory invention registrations in a subclass....\$ 3.00
- (e) Uncertified statement as to status of the payment of maintenance fees due on a patent or expiration of a patent....\$ 10.00
- (f) Uncertified copy of a non-United States patent document, per document....\$ 25.00
- (g) [Reserved]
- (h) [Reserved].

[Added 47 Fed. Reg. 41273, Sept. 17, 1982, effective date Oct. 1, 1982; para. (b), 49 Fed. Reg. 552, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (f) and (g) Added, 49 Fed. Reg. 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (a) and (c), 50 Fed. Reg. 9379, Mar. 7, 1985, effective date May 8, 1985; 50 Fed. Reg. 31825, Aug. 6, 1985, effective date Oct. 5, 1985; revised, 54 Fed. Reg. 6893, Feb. 15, 1989; 54 Fed. Reg. 9432, March 7, 1989, effective Apr. 17, 1989, revised 56 Fed. Reg. 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (b)(4), (f) and (h), 57 Fed. Reg. 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (a)(3), 58 Fed. Reg. 38719, July 20, 1993, effective Oct. 1, 1993; paras. (a)(1)(ii), (a)(1)(iii), (b)(1)(i), & (b)(1)(ii) amended, 60 Fed. Reg. 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(2) and (a)(3) amended, 62 Fed. Reg. 40450, July 29, 1997, effective Oct. 1, 1997; paras. (a)(1)(i) through (a)(1)(iii) revised, 64 FR 67486, Dec. 2, 1999, effective Dec. 2, 1999, introductory text and paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (g) and (h) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

declaration by you pursuant to 37 C.F.R. §1.63.<sup>4</sup>

Requests for information regarding your application should be directed to the File

<sup>4</sup> The regulations at 37 C.F.R. §1.63 provide:

**§1.63 Oath or declaration.**

(a) An oath or declaration filed under § 1.51(b)(2) as a part of an application must:

- (1) Be executed in accordance with either § 1.66 or § 1.68;
- (2) Identify the specification to which it is directed;
- (3) Identify each inventor by: full name, including the family name, and at least one given name without abbreviation together with any other given name or initial, and the residence, post office address and country of citizenship of each inventor; and
- (4) State whether the inventor is a sole or joint inventor of the invention claimed.

(b) In addition to meeting the requirements of paragraph (a), the oath or declaration must state that the person making the oath or declaration:

- (1) Has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration;
- (2) Believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and
- (3) Acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56.

(c) In addition to meeting the requirements of paragraphs (a) and (b) of this section, the oath or declaration in any application in which a claim for foreign priority is made pursuant to § 1.55 must identify the foreign application for patent or inventor's certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

(d)--

(1) A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:

- (i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;
- (ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;

(iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and

(iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

(2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.

(3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and

(ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

(4) Where the power of attorney (or authorization of agent) or correspondence address was changed during the prosecution of the prior application, the change in power of attorney (or authorization of agent) or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney (or authorization of agent) or correspondence address during the prosecution of the prior application.

(5) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application.

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application. The oath or declaration in any continuation-in-part application must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

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[48 Fed. Reg. 2711, Jan. 20, 1983, added effective Feb. 27, 1983; 48 Fed. Reg. 4285, Jan. 31, 1983; paras. (b)(3) and (d), 57 Fed. Reg. 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (a) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (d) revised, para. (e) added, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

Information Unit at (703) 308-2733.

Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or toll-free: (800) 972-6382 (outside the Washington D.C. area).

Telephone inquiries regarding this communication should be directed to Kathy Matecki at (703)305-1645.



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